REMARKS

An Office Action was mailed on December 10, 2003. Claims 1-12 are pending.

INFORMATION DISCLOSURE STATEMENT

Applicant is submitting herewith an Information Disclosure Statement for the review and consideration of the Examiner.

DRAWINGS

The Examiner objected to the drawings because the image capture feature is not shown. Responsive thereto, Applicant has amended the claims to render such drawing objection moot.

The Examiner also noted that FIG. 2 and the discussion of the controller in the Detailed Description should be designated as prior art. Applicant respectfully disagrees with the Examiner because Applicant did not specifically designate the controller as prior art in the Background of the Invention section or in any other section of the application. It is irrelevant that such controller may be illustrated in another patent, since prior illustration does not automatically render something as "prior art." Furthermore, Applicant described such controller in the "Detailed Description of the Preferred Embodiment" section of the application, which means that the controller is illustrated as part of the preferred embodiment of the present invention and to illustrate the operation of the present invention. In this regard, the Examiner is respectfully directed to pages 11-24 of the specification (see, for example, page 12, beginning with line 5), which clearly illustrate use of the controller of the invention of FIG. 2 for operation of the video game of the present invention as illustrated in the other figures of the present application.

OBJECTION TO THE CLAIMS

Claims 7-9 are objected to for wording informalities. Responsive thereto, Applicant has amended the claims as suggested by the Examiner to overcome such informality objections. Accordingly, it is respectfully requested that the Examiner withdraw his objection to the claims.

REJECTIONS UNDER 35 U.S.C. § 101

Claim 12 is rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Responsive thereto, Applicant has amended such claim to provide that the program is stored in a computer-readable medium. Accordingly, the Examiner is respectfully requested to withdraw the §101 rejection to claim 12.

REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 2 and 3 rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Responsive thereto, Applicant has canceled such claims, thereby rendering the rejection moot.

Claim 4 is rejected under 35 U.S.C. §112, first paragraph, because of the term "stereographically." The Examiner references something having to do with special viewing apparatus. However, with reference to the definition found at www.dictionary.com and other websites, the term "stereography" refers to the art or technique of depicting solid bodies on a plane surface, or by delineation on a plane. This is exemplified by the figures of the present invention showing the game characters on the display. Accordingly, the Examiner is respectfully requested to withdraw the §112, first paragraph rejection to claim 4.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-12 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Responsive thereto, Applicant has amended the claims to overcome such §112, second paragraph rejections. Applicant has modified the originally-claimed concept of "extraction" of an image to the obtaining of an image from a source, which is similar to the concept as understood by the Examiner and as set forth in the specification and drawings (see, for example S2 of FIG. 3). Accordingly, it is respectfully requested that the Examiner withdraw the rejections under 35 U.S.C. § 112, second paragraph.

PRIOR ART REJECTIONS

Claims 1-6 and 10-12 are rejected under 35 U.S.C. §102(b) as being anticipated by Sitrick (U.S. Patent 5,553,864), while claims 7-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sitrick in view of Morhira (U.S. Patent 6,361,438). Claims 1, 2, 4, 5 and 10-12 are further rejected under 35 U.S.C. §102(b) as being anticipated by Kaji et al. (U.S. Patent 6,183,367).

Responsive thereto, Applicant has clarified the present invention by setting forth the following steps inherent in the amended claims:

obtaining a complete image from a source;

extracting a partial image from the complete image, which results in said complete image becoming a modified image;

adding a visual effect to the extracted partial image;

displaying the modified image; and

displaying the partial image added with the visual effect in a moving motion.

Support for such steps are clearly found in the specification and the drawings with respect to operation of the game of the present invention as set forth in more detail below.

In all of the prior art cited by the Examiner, a game character or a user-defined object is generated with reference to a user-defined or predetermined image. For example, in the Sitrick reference, columns 24-26 and FIGS. 5A and 5B set forth that a user is able to create customized video game components from user-defined images, which components may then be incorporated into videogame audiovisual presentation. Similarly in the Kaji et al. reference, a personalized game character can be generated from user-defined video data (see, for example, column 3, lines 33-37), wherein only the extracted game character is used in the video game environment. In each of these references, a "captured" image from a larger image is separately incorporated into a game environment, while the remaining "un-captured" portions of the image remain unused. See also customer 22 of the non-asserted Parulski et al. '389 reference, player image 78 of the non-asserted Breslow et al. '873 reference and characters 23, 25 and 31 of the non-asserted Yamamoto '731 reference.

In the present invention, the entirety of the image, defined by the portion of the image that is extracted and the image the remains after extraction (defined in the claims as the "modified image"), is utilized and both the extracted image and the modified image are both displayed during execution of the game. The Examiner is respectfully directed to page 9, lines 7-13 and page 10, lines 11-24 and FIGS. 4A-4E of the present application. In other words, the extracted portion of the original image is transformed into a character, missile, etc., through the addition of visual effects or the like, while the remaining portions of the image, i.e., the modified image, form the background of the display. Thus, a clear distinction between the present invention and the state of the prior art is the utilization of both extracted (moving) and non-extracted portions of an image in a video game or the like.

Accordingly, Applicant respectfully submits that the claims as amended are not taught by any of the cited art. The Manual For Patenting Examining Procedure (MPEP) § 2131 clearly sets forth the standard for rejecting a claim under 35 U.S.C. § 102(b). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." (MPEP § 2131, quoting Verdegaal Bros. v. Union Oil Co. of California 2 USPQ2d 1051, 1053 (Fed Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ...claim." (MPEP § 2131, quoting Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). "The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e. identity of terminology is not required." (MPEP § 2131, citing In re Bond, 15 USPQ2d 1566 (Fed. Cir. 1990)).

In this case, the cited art fails to teach or reasonably suggest a program, device, system, etc. whereby a complete image is obtained from a source, a partial image is extracted from the complete image, thereby transforming the complete image into a modified image, a visual effect is added to the extracted partial image and the partial image is then set into motion and displayed along with the modified image from which the extracted partial image originated. As noted above, the prior art is only concerned with the utilization of an extracted portion of an image in a game environment or the like and is not concerned with the utilization of an entire image as a background for a moving, visually-enhanced extracted portion from said entire image.

Accordingly, it is respectfully requested that the Examiner withdraw the rejections under 35 U.S.C. § 102. It is also respectfully requested that the Examiner withdraw the rejections under 35 U.S.C. § 103 through dependency.

For the foregoing reasons, reconsideration is respectfully requested.

An earnest effort has been made to be fully responsive to the Examiner's objections. In view of the above amendments and remarks, it is believed that claims 1 and 4-12, consisting of independent claims 1 and 10-12 and the claims dependent therefrom, are in condition for allowance. Passage of this case to allowance is earnestly solicited. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged on Deposit Account 50-1290.

Respectfully submitted,

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